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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,041	03/26/2004	Kazuya Matsumoto	17575	9537

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/811,041

Applicant(s)

MATSUMOTO ET AL.

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 103**

- [01] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [02] Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,681,260) in view of Biglieri (6,958,577).

### **Response to Arguments**

- [03] Applicant's arguments filed 2/6/2006 have been fully considered but they are not persuasive.
- [04] The rejections set forth in the Office action of 11/10/2005 rely upon the combination of Ueda and Biglieri. The combination is contested as follows.
- [05] Firstly, Applicant contends that "the magnetic structure of Biglieri is not used to control the movement of anything, but is merely used for imaging. Thus, even the combination of Ueda and Biglieri does not disclose all of the features of independent claim 1." This is unpersuasive because Biglieri does in fact control the movement of a "magnetic structure 1," a "patient table 2," or "both ... relative to each other," as noted in [05] of the Office action of 11/10/2005. As noted in [04] of the Office action of 11/10/2005, the only element which Ueda does not disclose is "moving means for moving the examination table relative to the magnetic-field generating means." It is maintained that Biglieri discloses such a moving means, and that the combination of Ueda and Biglieri discloses all of the features in the

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independent claim.

[06] Secondly, Applicant contends that "there is no motivation or suggestion to combine the teachings of the Ueda reference with the teachings of the Biglieri reference." As noted in the Office action of 11/10/2005, Biglieri teaches that moving a patient table relative to a magnetic structure is an obvious and equivalent alternative to the movement of a magnetic structure relative to a patient table. In reduction to practice, a skilled artisan is motivated to use obvious and equivalent alternatives. Applicant further contends that because the references "are directed to solving different problems, those of ordinary skill in the art could not have been motivated to combine the teachings thereof." It is maintained that both Ueda and Biglieri are concerned with the relative movement of an examination table and a magnetic-field generating means.

[07] Thirdly Applicant contends that the Biglieri reference is "from a non-analogous art because it is directed to a different field of endeavor... and directed to solving a different problem." With regard to the first contention, it is maintained that the capsule endoscope system (of Ueda) and the MRI system (of Biglieri) are in the same field of endeavor because:

[07a] Both are concerned with medical imaging of a patient accommodated by an examination table.

[07b] Both require the relative movement of the examination table and a magnetic-field generating means in order to provide medical images.

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[08] With regard to the second contention, it is maintained that the Biglieri reference is reasonably pertinent to the particular problem with which the inventor of the present invention was involved. Ueda is confronted with the problem of moving a "magnetic force generating part 31" and a "bed 10" relative to one another. Biglieri is confronted with the problem of moving a "magnetic structure 1" and a "patient table 2" relative to one another. Ueda proposes the movement of the "magnetic force generating part 31" relative to the "bed 10". Biglieri, as noted above, proposes that "the magnetic structure 1, or the patient table 2, or both may be displaced relative to each other."

[09] It is maintained that in view of Biglieri, a skilled artisan would be motivated to modify Ueda such that the examination table moves relative to the magnetic-field generating means as opposed to vice-versa, and would do so upon reduction to practice because Biglieri shows them to be obvious and equivalent alternatives.

### **Conclusion**

[10] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

[11] A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

- [12] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [13] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [14] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[15] prs



John P. Leubecker  
Primary Examiner